

REMARKS

Claims 55-75 are pending in the application. Claims 55-73 were withdrawn by the Examiner, and claim 74 was examined. Claims 53-59 and 62-74 are currently amended. New claim 75 is added.

The amendments and new claim do not present new matter, particularly considering that that there is no requirement that a claim amendment must include exactly the same nomenclature as provided in the specification and support for claim amendments can be supported by express, inherent or implicit disclosure. MPEP §608.01; MPEP §2163 (While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure). *See, e.g.*, claims as filed; p. 7, lines 13-24 (probe 100 includes a relatively short shaft 102); Figs. 1 and 2 (single shaft 102; coagulation electrodes 110 and stimulation electrodes 112, 114 on the distal portion 108 of the same single shaft 102). Further, since the coagulation electrodes and stimulation electrodes are fixed on the same shaft, it is well understood that they do not move relative to each other. Reconsideration and allowance of claims 74-75 and the withdrawn claims as amended, are respectfully requested.

The sole rejection in the Office Action is a rejection of independent claim 74 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,010,500 to Sherman ("Sherman"). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Applicant respectfully submits the rejection is moot.

It is alleged in the Office Action that the "relatively short shaft" is the portion of the inner shaft 12 that extends "from a point proximal of the most proximal 32 to the distal end of 12." Office Action (p. 2). Thus, it is alleged that the "relatively short shaft" is a distal portion of the inner shaft 12. It is further alleged in the Office Action that a ring electrode 18 is a "coagulation element" and that the radiopaque markers 38a and 38b define a "stimulation element."

Sherman fails to disclose "a single relatively short shaft defining a distal region and a proximal region" as recited in claim 74. Thus, claim 74 recites one shaft, not multiple shafts. In contrast, Sherman describes a specific configuration involving two different shafts, *i.e.*, an inner shaft 12 and a separate and independently controllable outer shaft 14. Sherman (col. 4, lines 1-2; Fig. 1); Office Action (p. 7) (noting different inner shaft 12 and outer shaft 14 components). As such, Sherman describes a structural configuration that is the opposite of the configuration recited in claim 74 and cannot support the rejection for this reason alone.

Sherman also fails to disclose the combination of “an ablation element defining an ablation element configuration on the distal region of the same single relatively short shaft” and “a stimulation element defining a stimulation element configuration on the distal region of the same single relatively short shaft” as recited in claim 74. Thus, as recited in claim 74, the ablation element and the stimulation element are on the same, single shaft, not different shafts. In contrast, as discussed above, Sherman describes a specific multi-shaft configuration that involves an inner shaft 12 and an outer shaft 14 for telescopically receiving the inner shaft 12. Sherman explains that the cited electrodes 18 of the ablation section 16 are on the inner shaft 12, whereas the cited radiopaque markers 38a and 38b are on the other, outer shaft 14. Other structural features disclosed by Sherman are specifically provided for this particular multi-shaft structure. For example, Sherman also discloses a window 36 formed in the outer shaft 14 such that during use, the surgeon can insert the inner shaft 12 having the electrodes 18 into the outer shaft 14, position the ablation section 16 adjacent to the window 36, which is adjacent to tissue to be ablated, and commence delivery of RF energy to tissue once positioned adjacent to the window 36. Further, the window 36 allows for electrolytic fluid that was utilized during delivery of RF energy to flow out through the window 36. Accordingly, Sherman discloses a very different structural configuration than the configuration recited in claim 74.

Sherman also fails to disclose “wherein the ablation element comprises a pair of longitudinally spaced ablation elements and the stimulation element is located between the ablation elements, the stimulation element configuration being different than the ablation element configuration” as recited in claim 74. Thus, claim 74 recites that the stimulation element is located between the ablation elements, which are located on the same, single shaft as the stimulation element. Instead, as discussed above, Sherman discloses a multi-shaft structure in which the inner shaft 12 includes the cited electrodes 18 and the outer shaft 14 includes the cited radiopaque markers 38a, 38b such that in Sherman, the radiopaque markers are not between the cited electrodes on the same shaft as recited in claim 74.

In view of the multiple, substantial deficiencies of Sherman, it is respectfully requested that the rejection of claim 74 under 35 U.S.C. §102(b) be withdrawn. Dependent claim 75 incorporates the elements and limitations of respective independent claim 74 and, therefore, is also believed novel over Sherman for at least the same reasons.

Further, Sherman fails to disclose “wherein the ablation element and the stimulation element are fixed at respective locations on the same single relatively short shaft such that the location of the ablation element does not change relative to the location of the stimulation

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element on the same single relatively short shaft” as recited in claim 75. In contrast, Sherman explains that the inner shaft is inserted telescopically into the outer shaft and the “relative positions of the inner and outer shafts 12, 14 are adjusted by sliding one relative to the other.” Sherman (col. 5, lines 61-63) (emphasis added). Thus, Sherman describes a very different structural configuration that is the opposite of the configuration recited in claim 75.

If there are any remaining issues that can be resolved by telephone, Applicant invite the Examiner to kindly contact the undersigned at the number indicated below.

Respectfully submitted,

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Dated: September 8, 2010

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